



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,536	09/22/2003	Tetsuro Motoyama	241505US CIP	5927
22850	7590	10/29/2007		
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER CHANKONG, DOHM	
			ART UNIT	PAPER NUMBER
			2152	
			NOTIFICATION DATE	DELIVERY MODE
			10/29/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

patentdocket@oblon.com
oblonpat@oblon.com
jgardner@oblon.com

Office Action Summary

Application No.

10/665,536

Applicant(s)

MOTOYAMA, TETSURO

Examiner

Dohm Chankong

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17:2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 9/11/07.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

Art Unit: 2152

DETAILED ACTION

1> This action is in response to Applicant's arguments filed 8.23.2007. Claims 20, 22, and 26 are amended. Claims 1-28 are presented for further examination.

2> This is a non-final rejection.

Response to Arguments

3> Applicant argues that the cited references do not qualify as prior art because the claims of the instant application are entitled to the filing date of September 29, 1999. The instant application is a continuation-in-part of now issued patent no. 6,631,247 [the '247 patent] which was filed on September 29, 1999. Applicant's arguments are persuasive as the subject matter relied upon in the claims of the instant application are recited in the specification of patent 6,631,247.

Therefore, the rejections set forth in the previous action are withdrawn. But new grounds of rejection are set forth in this action in light of new prior art.

4> Additionally, Applicant argues that the double-patenting rejections of the claims should be withdrawn in light of the terminal disclaimer filed 8.23.2007. It is noted that the terminal disclaimer filed by Applicant only applies to the double patenting rejection of the '247 patent. Therefore, the other double patenting rejections set forth in the previous action are maintained.

Information Disclosure Statement

5> The information disclosure statements filed on (all in 2004) February 13, March 2, March 9, March 22, March 29, April 9, May 4, June 1, June 14, June 22 and April 14, 2005 fail to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because they fail to provide: the application number of the application in which the IDS is being submitted (37 CFR 1.98(a)(1)(ii)) and a column that provides a space, next to each document to be considered, for the examiner's initials (37 CFR 1.98(a)(1)(ii)).

They have been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

6> The IDS filed on 9.11.2007 has been considered.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re*

Art Unit: 2152

Goodman, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7> Claims 1-28 rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-20 of U.S. Patent No. 6,714,971 ['971 patent]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '971 patent claims.

Claim 1 of the instant application recites a network device that transmits a message to a first computer, the first computer then transmitting a communication comprising the message to a second computer. Claim 1 of the '971 patent recites a first device transmitting a message to a first computer, determining whether the message should be forwarded in a communication and transmitting this communication from the first computer to a first end user. The only difference here being that claim 1 of the '971 patent recites a "first end user" rather than a second computer. But this is simply a variation in terminology because it is clearly implied that the first end user accesses the communication from a computer; therefore, a first computer is still transmitting a computer to a second computer.

Art Unit: 2152

8> Claims 1-28 are also provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-49 of copending Application No. 10/638,540 ['540 application]. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of the instant application are merely broadly written versions of the '540 application claims.

Claim 1 of the '540 application recites a network device transmitting a message to a service center computer with the service center computer transmitting a communication to a resource administration computer. Like the previous patent and applications, the only differences between the claims of the '540 application and the instant application are merely semantic. The differences in terminology do not change the fact that the functionality is the same: a first device transmitting a message to a second device, the second device analyzing the message for a communication and the second device transmitting the communication to a third device. The claims of this instant application are written even more broadly than those here. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 2152

9> Claims 1-22, 25, and 26 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan et al, U.S Patent No. 6,310,692 ["Fan"].

10> Fan was previously cited in the PTO-892 filed on 6.22.2007.

11> As to claim 1, Fan discloses a method of processing messages, comprising:

transmitting a message from a network device to a first computer that is remote from said network device, said message including information obtained from sensors of the network device [Figure 3 «items 250, 248» where : Fan's resource manager reads on claimed first computer and Fan's printer reads on claimed network device | column 4 «line 63» to column 5 «line 14». Fan does not expressly disclose that the printer has sensors but this function is implied by the fact that the printer provides resource information to the first computer];

receiving the message by the first computer [column 5 «lines 1-14»];

determining, by the first computer, if a communication containing at least part of the message, including at least some of the information obtained from the sensors, is to be transmitted from the first computer to a second computer [Figure 3 «item 220» | column 5 «lines 18-26 and 45-53»];

transmitting the communication from the first computer to the second computer in response to the determination made by the first computer [column 4 «lines 11-14» :

transmitting the notification to the client computer | column 5 «lines 45-59»]; and

receiving said communication by the second computer [column 5 «lines 45-59»].

12> As to claim 2, Fan discloses the message comprises information regarding usage of the device [column 4 «lines 20-29» : usage of printer resources].

13> As to claim 3, Fan does disclose that the device sends messages to the first computer [column 5 «lines 3-11»] but Fan does not expressly disclose the message comprises an Internet electronic mail message. Sending emails containing status information from a monitored device to a monitoring device is well known in the art. Fan describes a pushing based method of sending messages whereby the printer initiates the process of sending status information to a supervising computer [column 5 «lines 3-14»].

It would have been obvious to one of ordinary skill in the art to have implemented email into Fan because email is a well known push-based messaging system. Email functionality has several benefits including the ability submit usage information when no response is required from the receiving party.

14> As to claim 4, Fan discloses the communication generated by the first computer comprises an Internet electronic mail message [column 4 «lines 59-62»].

15> As to claim 5, Fan discloses the communication generated by the first computer comprises an Internet electronic mail message [column 4 «lines 59-62»]. Fan does not expressly disclose the message comprises an Internet electronic mail message. See rejection of claim 3.

16> As to claim 6, Fan discloses:

generating, by the first computer, the communication to include summary information regarding usage of the device [column 4 «lines 20-29 and 51-59»];

wherein the step of transmitting the communication from the first computer comprises transmitting, by the first computer, the communication that includes the information regarding usage of the device to the second computer [column 4 «lines 20-29 and 51-59»].

17> As to claims 7 and 8, Fan discloses the network device is a business office device, wherein the business office device is at least one of a printer, a copier, and a facsimile machine [Figure 3 «item 250»].

18> As to claim 9, Anderson discloses transmitting said message from the network device to the first computer without going through the second computer [Figure 3 «items 250, 240» where : the printer communicates directly with the server without going through the client].

19> As to claim 10, Anderson discloses transmitting a message from the network device to the second computer, said message including said information obtained from the sensors of the network device [column 4 «lines 20-29 and 51-59» where : the message of the printers resources is transmitted from the network device through the first computer to the administrator's computer].

20> As to claims 11-20, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 1-10, respectively.

21> As to claim 21, Fan discloses a method of monitoring at least one network device communicatively coupled to a local network, comprising:

accessing the at least one network device by a service center computer that is remote from said local network to obtain device status information of the at least one network device, including information obtained from sensors of the at least one network device [column 5 «lines 1-26» : pulling based model];

storing the obtained device status information [column 5 «lines 15-18»];

periodically processing the stored status information to generate a usage report for the at least one network device [column 4 «lines 49-62» : notifications on resource usage];

transmitting the usage report from the service center computer to a second computer [column 4 «lines 49-62»]; and

receiving the usage report by the second computer [column 4 «lines 49-62» : notifications sent to end users].

22> As to claim 22, Fan discloses transmitting the usage report from the first computer to the second computer as an e-mail message, wherein said email message is transmitted at an application layer [column 4 «lines 59-62»].

Art Unit: 2152

23> As to claims 25 and 26, as they do not teach or further define over previously claimed limitations, they are similarly rejected for at least the same reasons set forth for claims 21 and 22 respectively.

24> Claims 23 and 27 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan, in further view of Kolls, U.S Patent No. 6.601.040.

25> As to claims 23 and 27, Fan does disclose transmitting data from the first computer to the second computer but does not expressly disclose transmitting data as a facsimile message. Sending reports by fax is well known in the art.

For example, Kolls is directed towards a system for monitoring remote devices. Kolls expressly discloses that usage reports can be sent to administrators by fax [column 47 «lines 8-10»]. It would have been obvious to one of ordinary skill in the art to incorporate fax capability into Fan's system to increase the communications functionality of the system. Adding fax capability increases the number of options where a customer or staff can be notified of important information.

26> Claims 24 and 28 are rejected under 35 U.S.C §103(a) as being unpatentable over Fan, in view of Danknick et al, U.S Patent No. 5.901.286 [“Danknick”].

Art Unit: 2152

27> As to claims 24 and 28, Fan discloses receiving a request for transmission of the usage report from the second computer [column 1 «lines 33-36»]. Fan does not disclose translating the usage report into a format suitable for display on a web page.

Danknick discloses translating usage reports for printers into a format suitable for display on a web page [Figure 7 | column 4 «lines 50-60» | column 7 «lines 31-39»]. It would have been obvious to one of ordinary skill in the art to have modified Fan to include Danknick's web page functionality. One would have been so motivated in order to allow Fan's end users access to their printers through conventional technology like web browsers.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Dev et al, U.S Patent No. 5,436,909 : [column 3 «lines 43-62»];

Russell et al, U.S Patent No. 5,611,046 : [abstract];

Engel et al, U.S Patent No. 6,320,585;

Sekizawa, U.S Patent No. 6,430,711 :[abstract | Figure 1];

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dohm Chankong whose telephone number is 571.272.3942.

The examiner can normally be reached on Monday-Friday [8:30 AM to 4:30 PM].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on 571.272.3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2152

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DC



JEFFREY PWU
SUPERVISORY PATENT EXAMINER